



P19797.A10

Application No. 09/600,890

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Seiji SHIRAI et al.

Serial No : 09/600,890

Group Art Unit: 2827

Filed : August 16, 2000

Examiner: Tuan DINH

SPE: Kamand CUNEO

For : MULTILAYER PRINTED WIRING BOARD WITH FILLED VIAHOLE
STRUCTURE

**PETITION FOR WITHDRAWAL OF PREMATURE FINALITY UNDER 37
C.F.R. §1.181 AND M.P.E.P. §1002.02(c)**

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir :

Responsive to the Advisory Action of April 15, 2003, entry of Applicants' Response to the Final Office Action filed on March 10, 2003, consideration thereof and withdrawal of premature finality of the Office Action are respectfully requested, in view of the present Petition. Applicants understand that, under 37 C.F.R. §1.17, no fee is required for the filing and the consideration of this Petition. However, if the U.S. Patent and Trademark Office should deem such a Petition fee to be necessary, the same is hereby requested and the Commissioner is hereby authorized to charge the same or any fees necessary to consider this Petition and to preserve the pendency of this application to deposit account No. 19-0089.

STATEMENT OF FACTS

On May 24, 2002, a first Office Action on the merits was issued by the Examiner. In this first Office Action, the Examiner made numerous 35 U.S.C. §112, second paragraph, rejections. The Examiner also made prior art rejections under 35 U.S.C. §102 and §103.

In a Response filed on October 24, 2002, Applicants amended claims 1-5, 7, 9-14, 16-19, 21, 23-29 and 31-33 to address the first Office Action's numerous 35 U.S.C. §112, second paragraph rejections. In the same Response, Applicants also responded the Office Action's prior art rejections under 35 U.S.C. §102 and §103 by arguing that the Examiner's rejections were mistaken and not supported by the disclosure of the prior art documents cited by the Examiner.

On January 8, 2003, a "final" Office Action was issued. In this Office Action, the Examiner did not respond to any of Applicants' arguments against the prior art rejections. Instead, the Examiner relied on several new documents, U.S. Patent Nos. 5,208,656; 4,769,270 in combination with a previously cited document, U.S. Patent No. 6,294,744, to form a new ground of rejection to all pending claims and made this Office Action final. The Examiner stated that the finality of the Office Action is based on the position that Applicants' arguments made in response to the Office Action of May 24, 2002 are moot in view of the new grounds of rejection and that Applicants' amendment necessitated the new grounds of rejection.

On March 10, 2003, Applicants filed a Request for Withdrawal of Finality and a Response under 37 C.F.R. §1.116. In this submission, Applicants amended claims and pointed out to the Examiner that the amended claims are patentable over the newly cited documents and the combination of such documents with the previously cited documents.

On April 15, 2003, an Advisory Action was issued by the Examiner refusing to enter and to consider Applicant's March 10, 2003 Response. The Examiner stated that the claim amendment made in Applicant's March 10, 2003 Response raised new issues that require further search.

REMARKS

Applicants respectfully submit that that the finality of the Office Action of January 8, 2003 is premature and should be withdrawn (M.P.E.P. §706.07(c) and (d)). The claim amendment made in the Response filed on October 24, 2002, in response to the first Office action, did not change the scope of the claims substantively examined but merely responded to rejections under 35 U.S.C. §112, second paragraph. The Examiner understood, or should have understood, the scope of the claims before and after Applicants' amendment to be the same. For example, the Examiner rejected claim 7 in the first Office Action under 35 U.S.C. §112, second paragraph, stating the it was not clear "what the applicant meant of 'the ratio between the viahole diameter and interlaminar insulative resin layer is within a range of 1 to 4?' Does applicant meant of 'height, thickness or length?'" (Page 3, lines

10-13, of the first Office Action). The Examiner understood or assumed that it is the thickness, (not the height or the length) of the interlaminar insulative resin layer the Applicants were referring to in claim 7 because the Examiner also rejected claim 7 under 35 U.S.C. §103. In the same first Office Action on page 8, last paragraph, the Office Action states "As best understood to claim 7, 16, Don [sic] discloses a multilayer printed wiring board wherein the ratio between the viahole diameter and a thickness of interlaminar insulative resin layer is within a range of 1 to 4." (emphasis added). In Applicant's response to the first Office Action, Applicants amended claim 7 by inserting the word "thickness" after "resin layer." Therefore the scope of claim 7 has not been changed and a new rejection to the amended claim 7 with the same scope as understood by the Examiner in the first Office Action should not be made final in the second Office Action. The same is true for all other claims amended due to 35 U.S.C. §112, second paragraph, rejections. These amendments are not being repeated herein for reasons of economy and efficiency.

Therefore, because substantive rejections made in the Office Action of May 24, 2002 were not maintained (Applicants' argument thereto are deemed moot by the Examiner) and new grounds of rejections were introduced in the Office Action of January 8, 2003 for the first time, the new grounds of rejection are not necessitated by the amendment since the scope of the claims were not changed. The Applicants should be given a full and fair chance to respond to the Office Action's new grounds of rejection.


ACTION REQUESTED

Applicants respectfully request that the finality of the Office Action issued on January 8, 2003 be withdrawn. Applicants also respectfully request that Applicants' response filed on March 10, 2003 be officially entered into record and be considered by the Examiner.

CONCLUSION

In view of the foregoing and our Response filed on March 10, 2003, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

Respectfully submitted,
Seiji SHIRAI et al.



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May 6, 2003
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